

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: ~~32, 34-47~~.

The following claims are *independent*: 32.

Please *cancel* the following claims without prejudice or disclaimer: ~~1-31, 33~~.

Please *add new* claims ~~34-47~~ and please *amend* claim 32; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Objections

The Office Action objected to claims 24, 26-29, and 31 due to typographical errors noted by the Examiner. Applicant has canceled claims 24, 26-29, and 31 rendering the objection moot.

With regards to the objection to the Specification, Applicant is unclear as to whether the amendment to the specification submitted by the previous attorney in the Response to

Non-Final Office Action dated January 13, 2006 (received by the Office January 17, 2006 as indicated in PAIR) has been entered, and respectfully requests clarification from the Examiner.

Claim Rejections - 35 U.S.C. § 101

The Board Decision has rejected claims 1-21 and 25-31 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states “claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection.” MPEP § 2106 also discusses “[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.”

Applicant submits that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature. Though Applicant respectfully traverses the rejection, Applicant has canceled claims 1-21 and 25-31 rendering the rejection moot.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Birle Jr., et al., US Publication No. 2003/0130941 (hereinafter “Birle”), in further view of

Green et al., US Publication No. 2003/0093375 (hereinafter “Green”), and in further view of Barron's Dictionary of Finance (hereinafter “Barron's”).

Applicant respectfully traverses these rejections and submits that a *prima facie* showing of obviousness has not been made and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of the previously pending claims. Furthermore, Applicant has amended claim 32 to further clarify aspects of the claim, and distinctions between the claim elements and the prior art.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. (MPEP § 706.02(j))

Applicant submits that the rejections in the pending Office Action do not establish at least requirement(s) (A) and/or (B) of a *prima facie* showing of obviousness for amended independent claim 32.

Applicant submits Green does not discuss or render obvious at least the following element(s) as recited, *inter alia*, in independent claim 32:

A unit pricing device, comprising:

...

populate a first data structure with forward information, including a forward settlement date and a forward settlement

price, describing a forward transaction that obligates a holder to purchase a number of shares of the equity security associated with the issuer at the forward settlement date for the forward settlement price;

populate a second data structure with convertible note information, including a convertible note maturity date, a convertible note interest rate, a conversion ratio, a convertible note issue price and a convertible note principal amount, describing a convertible note that is convertible to the equity security associated with the issuer according to a specified conversion formula;

populate a third data structure with financial information associated with the equity security identifier from a data source;

populate a fourth data structure with financial information associated with the issuer identifier from a data source; and

calculate, based on data in the first data structure, data in the second data structure, data in the third data structure, and data in the fourth data structure, pricing data associated with a proposed unit comprising the forward transaction and the convertible note.

The Office Action asserts the claimed elements as in previously pending independent claim 32 are shown in Green. The Examiner admits that:

Birle does not explicitly disclose ... generate, based on said market information and said terms of said proposed unit, pricing data associated with said proposed unit; (Office Action, p. 13).

However, the Examiner attempts to remedy this deficiency in Birle by relying on Green and alleging that:

Green discloses the explicit computing steps of ... generate, based on said market information and said terms of said proposed unit, pricing data associated with said proposed unit (Fig. 2-4); (Office Action, p. 14).

Applicant disagrees with the Examiner's characterization of the cited reference as applied to the previously pending claim. However, in order to further clarify aspects of distinctions over

the prior art, Applicant has amended independent claim 32 and submits amended independent claim 32 is patentably distinct from the cited references.

In contrast to the amended claims, Applicant submits that Green essentially discusses a *convertible note simulator lacking any ability to handle forward settlement data*. For example, Applicant notes that Green discusses, “FIG. 2 shows some preferred embodiments of the method according to the invention to create or simulate a convertible or exchangeable financial instrument,” (Green, paragraph [0048]). Green further discusses that the simulator is, “may provide convertible and exchangeable features as an object,” (Green, paragraph [0033]). Green elaborates, “for example, a Conversion object may be selected and the input information may allow construction of a conversion payoff as a function of underlying stock price and time,” (Green, paragraph [0033]). However, Applicant submits that Green does not discuss the claimed “calculate, based on data in the first data structure, data in the second data structure, data in the third data structure, and data in the fourth data structure, pricing data associated with a proposed unit comprising the forward contract and the convertible note,” as recited in amended independent claim 32; nor as recited in the previously pending claim.

Accordingly, Applicant submits that Green’s *convertible note simulator lacking any ability to handle forward settlement data* is different from at least the claimed “calculate, based on data in the first data structure, data in the second data structure, data in the third data structure, and data in the fourth data structure, pricing data associated with a proposed unit comprising the forward contract and the convertible note,” as recited in claim 32. For at least the reasons discussed above, Applicant submits that the pending rejection has

mischaracterized the language of the claim element and/or the applied reference(s) and, thus, has not established a *prima facie* case of obviousness.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s).

Accordingly, by neglecting and/or mischaracterizing claim elements, Applicant submits that a *prima facie* showing of obviousness has not been established and thus the applied reference(s) do not discuss or render obvious at least these claimed elements. As such, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection and allowance of the claim(s). Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference.

CONCLUSION

Consequently, the reference(s) cited by this Office Action and/or any previous office action(s) (hereinafter “Office Action(s)”) do not result in the claimed invention(s), there

was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any Official Notice that has been taken and/or (mis)characterizations of claims made in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 32, 34-47, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to any Office Action(s) objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not

concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-455. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-455.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
Attorney(s) for Applicant,
CHADBOURNE & PARKE LLP

Dated: February 11, 2010

By: Walter G. Hanchuk/
Walter G. Hanchuk
Registration No.: 35,179

Correspondence Address:

CHADBOURNE & PARKE LLP
30 Rockefeller Plaza
New York, NY 10112

212-408-5100 (Telephone)
212-541-5369 (Facsimile)
patents@chadbourne.com (E-mail)